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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,546	12/05/2003	Carol J. Buck	3607-106.4 US	8795

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EXAMINER	
YU, GINA C	
ART UNIT	**PAPER NUMBER**
1617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/728,546	BUCK, CAROL J.	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-33 and 45-56* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-33 and 45-56* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of amendment filed on December 18, 2006. Claims 23-33, 45-56 are pending. Claim rejections as indicated in the previous Office action dated October 19, 2006, are withdrawn in view of claim amendments made by applicants. New rejections are made in view of the claim amendment in part, and in view of further consideration in part.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28, 29, 50 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 28, 29, 50 and 51 contain the trademark/trade names Alcalase ® 2.4L and Flavourzyme ®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade

name is used to identify/describe the enzymes rather than the source thereof and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 23-25, 30-33, 45-47, and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. (US 5002761) ("Mueller") in view of Derwent Acc. No. 1988-157179 (Abstract of JP 63096107 A) ("Shiseido") and Data Sourcebook for Food Scientists and Technologists (1991, Y. H. Hui) ("Hui").

Mueller teaches hair treatment composition comprising up to 20 wt % of an inorganic and/or an organic acid. See col. 2, lines 23 – 42; instant claims 30 and 52. Acetic acid is taught. See col. 2, lines 52-66; instant claims 32, 54, and 55. The operating examples show compositions comprising about 90.4-95 wt % of water. See instant claims 30 and 52. Perfumes are added in the compositions. See col. 4, lines 20 – 28; instant claims 31 and 53. The reference teaches that the prior art compositions are in the form of cream. See col. 3, lines 36 – col. 4, line 2; instant claims 33 and 56. The reference teaches that the treatment provides the wet and dry combability and reduces the electrostatic chargeability of the hair. The preambles of instant claims 23, 33, 45, and 56 are not given patentable weight, as discussed above. The reference

teaches adding thickeners, which act as 'gelling agent' of the instant claims. See col. 3, line 48 – col. 4, line 2.

Mueller fails to teach enzyme.

Shiseido teaches powder biological composition comprising Aspergillus oryzae. See abstract. The reference teaches that the powder is mixed with appropriate water or lotion and applied to hair, and provides luster to the hair.

Hui teaches that Aspergillus oryzae is a source of amylase enzyme. See instant claims 23, 25, 45, and 47.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Mueller by incorporating the cosmetic powder mixture which comprises enzymes such as Aspergillus oryzae, as motivated by Shiseido and Hui, because 1) both references are directed to hair treatment compositions having aqueous phase art; and 2) Shiseido teaches that biological materials comprising Aspergillus oryzae provide luster to hair; and 3) Hui teaches that Aspergillus oryzae contains enzymes. The skilled artisan would have had a reasonable expectation of successfully producing a stable composition because the Mueller composition is an aqueous emulsion base and Shiseido teaches that the enzyme material is mixed in aqueous compositions.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23-25, 30-33, 45-47, and 52-56 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,517,822 B1 in view of in view of Shiseido and Hui.

Claim 1 of the '822 patent is directed to a composition consisting essentially of about 8-30 % by weight of at least one alkanoic acid, an acceptable diluent, and less than about 30 % of at least one auxiliary component selected from a fragrance, an odor masker, conditioner, gelling agent and penetration enhancer. See instant claims 23, 24, 30-33, 45, 46, 52-56.

The '822 does not disclose using enzyme in the composition, however, claim 1 is open to include a conditioner, and claims 2 and 3 of the patent further include at least one more auxiliary component.

Shiseido, as discussed above, teaches powder biological composition comprising Aspergillus oryzae. See abstract. The reference teaches that the powder is mixed with appropriate water or lotion and applied to hair, and provides luster to the hair.

Hui teaches that Aspergillus oryzae is a source of amylase enzyme. See instant claims 23, 25, 45, and 47.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the claimed invention of '822 by incorporating biological cosmetic material which comprises enzyme, as motivated by Shiseido and Hui, because 1) both '822 and Shiseido are directed to hair treatment compositions having aqueous phase; 2) the '822 composition comprises auxiliary agents; and 3) Shiseido teaches the biological materials which provide luster to hair, and, according to Hui, comprises enzymes. The skilled artisan would have had a reasonable expectation of successfully producing a stable composition because the '822 composition has an aqueous base and Shiseido teaches that the enzyme material is mixed in aqueous compositions.

Allowable Subject Matter

Claims 28, 29, 50, and 51 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 26, 27, 48, and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on December 18, 2006 have been fully considered but they are not persuasive in part and moot in view of the new grounds of rejection in part.

Applicant's arguments regarding the § 102 rejections of the previous Office action are moot in view of the claim amendments made by applicants.

With respect to the § 103 rejection, applicants argue that the prior arts fail to teach adding gelling agents to the composition. The argument is unpersuasive because Mueller in fact teaches using thickening agents to adjust the viscosity of the composition.

Applicant's assertion that Aspergillus is known as a disease-causing agent and therefore the skilled artisan would not combine the Shiseido, Hui, and Mueller references is unpersuasive. Shiseido only teaches that that the enzyme is useful in hair treatment, and it would have been obvious for the routineer to combine the teaching with the teachings from other hair cosmetic references with the specific intention of producing a hair treatment composition. Furthermore, applicant is also employing the broad class of amylase enzymes, to which Aspergillus belongs. It cannot be said that a certain species is unsuitable for the purpose of the applicant's invention, when the pending claims are directed to the genus. Also, the obviousness double patenting rejection is viewed proper for the analogous reason.

Conclusion

Claims 26, 27, 48, 49 are objected to.

Claims 23-25, 28, 29, 30-33, 45-47, 50-56 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gina C. Yu
Patent Examiner